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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10347288	01/21/2003	Atsuro Nakazato	SHI-C306	6687

7590 05/11/2004  
LORUSSO & LOUD  
3137 Mount Vernon Avenue  
Alexandria, VA 22305

EXAMINER

HARTE, KAHSAV

ART UNIT PAPER NUMBER

1624

DATE MAILED: 05/11/2004

5/28/04

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/482,235

Applicant(s)

WOOD ET AL.

Examiner

Brenda Coleman

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-5,8-16,19-24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5,8-16,19-24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_\_
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) ☐ Notice of Informal Patent Application (PTO-152)
- Paper No(s)/Mail Date. \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claims 3-5, 8-16, 19-24, 26 and 27 are pending in the application.

This action is in response to applicants' amendment dated December 29, 2003. Claims 3, 8, 9, 11-13, 16, 19-21, 23 and 24 have been amended, claims 1, 17 and 25 have been canceled and claims 26 and 27 are newly added.

#### ***Response to Arguments***

Applicants' arguments filed December 29, 2003 have been fully considered with the following effect:

1. With regards to the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 3) of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicants failed to comment on the 35 U.S.C. § 112, first paragraph rejection of claims 1, 3-5, 8-17 and 19-25 which is directed to the definition of X where "X represents S and/or O".

Claims 3-5, 8-16, 19-24, 26 and 27 are rejected under 35 U.S.C. § 112, first paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

2. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 1, 3-5, 8-17 and 19-24 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note In re Scheiber 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. The applicants are urging benefit of provisional application No. 60/002,164, however, since the instant application is not claiming benefit of 60/002,164 directly, they are not entitled to benefit of August 11, 1995. Provisional application No. 60/002,164 must be pending at the time of filing of the non-provisional application. The applicants cannot ignore the fact there are several non-provisional applications between the filing of the provisional and the instant application where the definition for instant R is not described. Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters, for reasons of record and stated above.

3. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 1, 3-5, 8-17 and 19-24 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only completely described in the U.S. Application

No. 09/206,082 filed December 4, 1998. Note In re Scheiber 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120. The applicants are urging benefit of provisional application No. 60/002,164, however, since the instant application is not claiming benefit of 60/002,164 directly, they are not entitled to benefit of August 11, 1995. Provisional application No. 60/002,164 must be pending at the time of filing of the non-provisional application. The applicants cannot ignore the fact the there are several non-provisional applications between the filing of the provisional and the instant application where the definition for instant R is not described. Hence, applicants are only entitled to a filing date of December 4, 1998.

Claims 3-5, 8-16, 19-24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of American Chemical Society, for reasons of record and stated above.

4. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph labeled paragraph 7 in the last office action, which is hereby **withdrawn**.

5. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled a), b), c), d), e), f), g), i), j, k) and l) of the last office action, which are hereby **withdrawn**. However, with regards to the 35 U.S.C. § 112, second paragraph rejections labeled h) the applicant's amendments and remarks have been fully considered but they are not persuasive.

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h) The applicants' stated that "claim 12 is now dependent on claim 26, which affirmatively recite that R can be methyl or HOCH<sub>2</sub>". However, claim 26 does not affirmatively recite that R can be HOCH<sub>2</sub>.

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for reasons of record and stated above.

In view of the amendment dated December 29, 2003, the following new grounds of rejection and/or reinstated rejections apply:

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 26 and 27 and claims dependent thereon are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the process of claim 26 and 27 where R includes the definition where R is saturated or unsaturated, branched, linear, or cyclic alkyl, heteroalkyl, aryl, and heteroaryl; and mixtures of the foregoing, wherein hetero refers to O, S, N, or P is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda Coleman  
Primary Examiner Art Unit 1624  
April 30, 2004